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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/604,763 06/26/00 KATAYAMA

T 2185-0452P-S

EXAMINER
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HM22/0403

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CAMPAGNE, J	
ART UNIT	PAPER NUMBER

1619

DATE MAILED:

04/03/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/604,763

Applicant(s)

KATAYAMA ET AL.

Examiner

Jean-Michel Campagne

Art Unit

1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## OBJECTIONS

1. Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim, or amend the claim to place the claim in proper dependent form, or rewrite the claim in independent form. Claim 9, as described in the specification (p.7, lines 5-7), refers to inventive esters where a dimer acid comprises two carboxylic acids to be esterified rather than a dimer comprising two alcohols to be esterified (as in Claims 1 and 7). Thus, this is not narrowing down claims from which Claim 9 depend, but rather, an entirely different claim. Please refer to 112 Rejection of Claim 9 below.

## 112 REJECTIONS

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-17 are vague and indefinite because of the word "with" as used therein. For example, Claim 1 states "a dimerdiol ester with a monocarboxylic acid." Does the material comprise a dimerdiol ester **and** an acid or does it comprise a dimerdiol ester **of** an acid?

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Claim 1 is confusing because it is unclear if the material comprises a dimerdiol ester of a mono- or dicarboxylic acid or if it comprises a dimerdiol ester **or** a dicarboxylic acid.

Claim 9 is unclear because it is not certain if Applicant intended dimer acids in general or dimerdiacid as defined on p.7, lines 5-7. If it is the latter, please refer to claim objection above.

Claims 10, 12, and 15 are indefinite because they lack periods and it is not certain whether Applicant intended to add more text to said Claims.

## 102 REJECTIONS

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 3, and 10 are rejected under 35 U.S.C. 102(b) as being disclosed by Kigawa et al. (U.S. Patent No. 5,798,434).

**Kigawa et al.** disclose a monomer mixture and method for the preparation thereof (Abstract). The mixture consists of dimer diol/trimer triol mixtures which are subjected to esterification with  $\alpha$ ,  $\beta$ -unsaturated carboxylic acids (col.1, line 40-col.2, line 44). Said acids may be those having 3-8 carbon atoms and include methacrylic acid (col.3, lines 27-34). Table 2 (col.9, lines 1-17) shows an example of a mixture of methacrylate esters of dimer diols/trimer triols.

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Thus, Applicant claims and Kigawa et al. disclose a dimerdiol ester of an acid having 4-34 carbon atoms.

### 103 REJECTIONS

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 5, 7-9, 11-13, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. (U.S. Patent No.5,795,978) in view of Hartmann et al. (U.S. Patent No.5,739,190) taken with Akrongold et al. (U.S. Patent No.3,846,550).

**Ansmann et al.** disclose emulsifiers particularly suitable for the production of storable, high viscosity, and sensorially light o/w emulsions which are for use in cosmetic and/or pharmaceutical formulations (Abstract and col.1, lines 10-15). Suitable oils for said emulsions include "esters of linear and/or branched fatty acids with polyhydric alcohols (for example dimer diol or trimer diol) and/or Guerbert alcohols" (col.4, lines 39-56). Suitable oils may make up 5-99% by weight of the non-aqueous component of the emulsions (col.4, lines 54-56). Ansmann et al. fail to specify carboxylic acids, claimed by Applicant, to make said esters.

**Hartmann et al.** disclose a process for the preparation of stable water-in-oil emulsions (Abstract). Said emulsions are used as flocculating agents, retention agents, and dispersing agents (col.1, lines 8-16). The oily phase of said emulsion can consist of

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aliphatic dicarboxylic acid esters and preferred types are those of adipic and sebacic acids (col.5, lines 29-33). Suitable water-in-oil emulsifiers include polyglycerol fatty acid esters made from polyhydric alcohols and long-chain fatty acids such as oleic, stearic, and palmitic acids (col.6, line 66-col.7, line 36).

**Akrongold et al.** disclose a cosmetic skin powder containing urea, an oil phase, and an inorganic pigment (Abstract). The invention, a resultant cosmetic film, is continuous and natural in appearance (col.1, lines 24-37). Oils that may be used in said powder include acids and alcohols which may be saturated or unsaturated, straight or branched chain, and have 5-52 carbons in the chain (col.1, lines 49-53). Acids included for said oils are oleic, stearic, isostearic, and dimer acids (such as Empol 1014), and further, esters thereof are encompassed (col.1, lines 53-60).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the general teachings of Ansmann et al., which teach the use of acid esters of dimerdiols in cosmetic formulations, by looking to the art for suitable acids for said esters, and then using suitable acids taught by Hartmann et al. and Akrongold et al. because of the expectation that said taught acids afford esters useful as cosmetic emulsifiers and suspending oils.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. (U.S. Patent No.5,795,978) as applied to claims 4, 5, 7-9, 11-13, 16, and 17 above in view of Bernhardt et al. (U.S. Patent No.4,788,054).

**Ansmann et al.** disclose (see discussion above). Ansmann et al. fail to disclose

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rosin esters for their inventive emulsions.

**Bernhardt et al.** disclose coating compositions which may comprise cosmetic emulsifiers and thickeners or viscosity modifiers (Abstract and col.8, line 38-col.9, line 16). Suitable thickeners include ester gums which are semi-synthetic reaction products of rosin and a polyhydric alcohol (col.8, lines 60-67).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the emulsion of Ansmann et al. by using a rosin acid ester of dimerdiol, a polyhydric alcohol, as taught by Bernhardt et al. because it is desirable to use a renewable natural starting material such as rosin and because of the expectation that rosin would afford an ester useful as a cosmetic thickener in said emulsion.

6. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansmann et al. (U.S. Patent No.5,795,978) as applied to claims 1-13, 16, and 17 in view of Clum et al. (U.S. Patent No.5,652,263).

**Ansmann et al.** disclose (see discussion above). Ansmann et al. fail to disclose the addition of vitamin E to their inventive emulsion, said emulsion for a cosmetic formulation.

**Clum et al.** disclose skin care compositions comprising a water-in-oil emulsion base (Abstract). Oil-soluble antioxidants which are useful in said compositions include  $\alpha$ -tocopherol or vitamin E (col.6, lines 10-17).

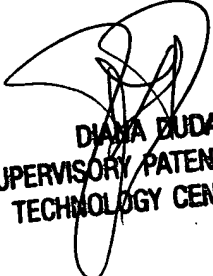
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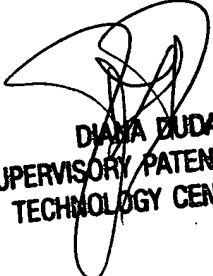
Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the invention of Ansmann et al. by further including vitamin E as taught Clum et al. because of the expectation that vitamin E would afford useful antioxidative properties to an end product cosmetic formulation.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean-Michel Campagne whose telephone number is (703)305-1903. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on (703)308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-4556 for regular communications and (703)308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1234.

  
Jean-Michel Campagne  
Examiner  
Art Unit 1619

  
DIANA DUDASH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

March 30, 2001